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In re Application of
NAKAMURA et al.
Application No.: 10/528,069
PCT No.: PCT/JP03/12353
Int. Filing Date: 26 September 2003
Priority Date: 27 September 2002
Attorney Docket No.: 122733
For: THERMAL TREATMENT APPARATUS,
METHOD FOR MANUFACTURING
SEMICONDUCTOR DEVICE, AND METHOD
FOR MANUFACTURING SUBSTRATE

SUPPLEMENTAL
DECISION

This decision is supplemental to the decision mailed 03 March 2006. That decision failed to take into account the declaration of facts by Mr. Akihiro Fukushima. Accordingly, the decision mailed 03 March 2006 is hereby VACATED.

BACKGROUND

On 26 September 2003, applicants filed international application PCT/JP03/12353, which designated the United States and claimed a priority date of 27 September 2002. A copy of the international application was communicated from the International Bureau to the USPTO on 08 April 2004. The thirty-month period for paying the basic national fee in the United States expired at midnight on 28 March 2005 (27 March 2005 being a Sunday).

On 15 March 2005, applicants filed a submission for entry into the national stage in the United States which was accompanied by, *inter alia*, the U.S. Basic National Fee and a translation of the application into English.

On 26 August 2005, the United States Designated/Elected Office (DO/EO/US) mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating, *inter alia*, that an oath or declaration of the inventors in compliance with 37 CFR 1.497(a)-(b) and the surcharge under 37 CFR 1.492(e) for providing the oath or declaration later than thirty months from the priority date were required.

On 07 October 2005, applicants filed the instant petition under 37 CFR 1.47(a) which was accompanied by, *inter alia*, a declaration of inventors, a declaration of facts by Mr. Akihiro

Fukushima, a copy of a letter sent to non-signing inventor Mr. Shimada on April 6, 2005 and an English translation thereof, a copy of a letter sent to Mr. Shimada on May 23, 2005 and an English translation thereof, and copies of two certified mail receipts and English translations thereof.

On 03 March 2006, a decision was mailed dismissing applicants' petition under 37 CFR 1.47(a). However, that decision failed to take into account the declaration of facts by Mr. Akihiro Fukushima.

DISCUSSION

Petition Under 37 CFR 1.47(a)

A petition under 37 CFR 1.47(a) must be accompanied by: (1) the fee under 37 CFR 1.17(h); (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort; (3) a statement of the last known address of the missing inventor; and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor.

As to item (1), the petition fee is \$200 rather than \$130. The balance of \$70 has been charged to Deposited Account 15-0461. Accordingly, item (1) has been met.

Item (3) and (4) have been met as well.

Item (2) has not been met. It is not clear whether it is being alleged that Mr. Tomoharu Shimada refuses to execute the application or that he cannot be reached after diligent effort. The two are distinct. *See, e.g.*, MPEP 409.03(d), item I. "Inventor Cannot Be Reached" and item II. "Refusal to Join." A first communication was sent to Mr. Shimada at a first address on 06 April 2005. A second communication was sent to Mr. Shimada at a second address on 23 May 2005. It is not clear why the communications were sent to two different addresses less than seven weeks apart. It is not clear whether Mr. Shimada resided at either of these addresses at the time the communications were sent. Accordingly, it is not clear if the inventor is no longer at either of these addresses and his whereabouts are unknown, or if he simply received one or both of the mailings and did not respond. If one or both of the mailings were received and the inventor did not respond, then a refusal to execute the application would likely need to be established. *See* MPEP § 409.03(d), item II. The inventor must be presented with a complete copy of the application papers (specification, including claims, drawing, and oath or declaration) for a refusal to be established. A complete copy of the application papers was sent to the first address but not to the second address in the instant situation. Thus, if Mr. Shimada resides at the second address, a complete copy of the application papers would still need to be presented to him. If it is being alleged that the inventor cannot be reached or found, copies of documentary evidence such as *internet searches*, certified mail return receipts, cover letters of instructions, and telegrams, that support a finding that the non-signing inventor could not be found or reached should be made part of the affidavit or declaration. *See* MPEP § 409.03, item I.

Translation

Applicants have not yet submitted an accurate translation of the international application as filed. In the translation filed 15 March 2005, a translation of the Figures was not provided. Unless the expression "Fig." is used to identify the drawing(s) in the international application as filed, the expression used to identify the drawing(s) must be translated. See PCT Rule 49.5(f). In the submission filed 15 March 2005, no such translation was provided.


CONCLUSION

For the above reasons, applicants' petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

For the above reasons, the decision mailed 03 March 2006 is hereby **VACATED**.

If reconsideration on the merits of this petition is desired, a proper response, including a translation of the Figures, must be filed within TWO (2) MONTHS from the mail date of this decision. **Failure to timely file the proper response will result in abandonment of this application.** Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)". No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

Please direct further correspondence with respect to this matter to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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